

II. General Remarks Concerning This Response

Claims 1-24 are currently pending in the present application. Claims 1, 3, 9, 17, and 19 have been amended herein. No claims have been added or canceled in this response. Reconsideration of the claims is respectfully requested.

Applicant notes that the Office action acknowledged the informal drawings that were filed on 12/15/2000 with the patent application. However, a set of formal drawings were filed with the PTO on 06/04/2001. Applicant requests an acknowledgment of the receipt of the formal drawings and an indication of whether or not the formal drawings were acceptable.

III. Summary of Present Invention

A method, system, apparatus, and computer program product are presented for management of a distributed data processing system. Resources within the distributed data processing system are dynamically discovered, and the discovered resources are adaptively monitored using the network management framework. A network or system administrator configures some mission critical endpoints with multiple network interface cards (NICs) and specifies mission critical endpoints, non-mission critical actions, etc. During status collection activities associated with network or system management activities, the categorization of an endpoint as a mission-critical or non-mission critical endpoint affects the manner in which the status collection activity is performed. Applications can request the performance of actions at endpoints without regard to the categorization of the endpoint or without regard to the categorization of the requested action, and the network management system routes the action based on whether or not the specified endpoint is a mission critical endpoint.

IV. 35 U.S.C. § 112, ¶ 2-Indefiniteness

The Office action has rejected claims 1, 9, and 17 of the present patent application as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office action states in its entirety: "(i.e.: a mission criticality characteristic is not defined in specification)." Applicant disagrees that the original claims were indefinite. Applicant intended the term "characteristic" to be interpreted as "categorization", and there is clearly a substantial amount of support in the specification for this term.

In order to further the prosecution of the patent application, though, Applicant has amended the claims to rewrite "characteristic" as "categorization". However, Applicant asserts that the claims have not been amended to avoid any rejections based on prior art. Moreover, given that the subject matter of the claims has not been substantively amended, Applicant asserts that any subsequent rejections cannot be made final based on a non-existent substantive change to the claimed subject matter.

V. 35 U.S.C. § 101-Double Patenting

The Office action has rejected claims 1-24 of the present patent application in an obviousness-type double patenting rejection over claims 1-21 of co-pending U.S. patent application 09/737,434, which is also assigned to IBM and has common co-inventors with the present application. This rejection is respectfully traversed.

MPEP § 804 states the following:

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obviousness-type double patenting analysis.

...

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims -- a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

The claims in the two patent applications clearly differ from each other; in fact, one independent claim from each patent application was copied into the Office action. For example, the independent claims of the other patent application include an element similar to "first associating means for associating a mission critical twin endpoint with each mission critical endpoint"; this feature does not appear in the claims of the present patent application. In addition, the independent claims of the present patent application include an element similar to "assigning means for assigning a mission criticality characteristic to each discovered endpoint"; this element does not appear in the claims of the other patent application. The simple fact that the claims in the different patent application may have common elements does not provide a basis for an obviousness-type double patenting rejection.

In addition, Applicant notes that the rejections that have been provided by the Patent Office in the respective Office actions on these patent applications have used completely different prior art references for rejecting the claims in each patent application, even though the rejections were written by the same examiner. One of ordinary skill in the art would reason that if the claims in the two patent applications are so similar as to warrant a double patenting rejection, then at least one rejection in each patent application would be based on a common prior art reference. Applicant asserts that the differing, multiple, grounds of rejection support the contention that the

respective claims in each patent application are not so similar as to be obvious in view of each other. Applicant also asserts that the multiple prior art rejections in each of the respective Office actions support the contention that the prior art references do not anticipate nor render obvious the respective claims because the basis for rejecting the claims has been intentionally obfuscated through multiple rejections that contain indefensible arguments.

More importantly, the rejection does not provide any reasons why a person of ordinary skill in the art would conclude that the invention defined in the claims of the present patent application is an obvious variation of the invention defined in the claims in the other patent application, as is required by a proper obviousness-type double patenting rejection. The onus is on the Patent Office for explaining the reasoning behind the rejection; without any reasoning against which to argue, Applicant cannot provide any arguments against the hypothetical reasoning. Applicant requests the withdrawal of the double patenting rejection.

VI. 35 U.S.C. § 102(e)–Anticipation–DuLac et al.

The Office action has rejected claims 1-24 under 35 U.S.C. § 102(e) as anticipated by DuLac et al., "Dual Bus Architecture for a Storage Device", U.S. Patent No. 5,748,871, filed 08/11/1995, issued 05/05/1998. This rejection is respectfully traversed.

The Office action begins by analyzing claim 9. Independent claim 9 reads as follows (as amended):

9. An apparatus for managing a distributed data processing system, the apparatus comprising:

configuring means for configuring monitoring parameters for network interface cards within the distributed data processing system using a network management framework;

discovering means for dynamically discovering endpoints within the distributed data processing system;

first determining means for determining that a device within the distributed data processing system has at least a first discovered endpoint representing a first network interface card and a second discovered endpoint representing a second network interface card; and

assigning means for assigning a mission criticality categorization to each discovered endpoint.

With respect to the first element of independent claim 9, the rejection does not point to the statement in DuLac et al. at column 3, line 60, of "[p]rograms supporting ... network management"; however, the rejection does point to this statement with respect to dependent claims 12 and 15.

With respect to the second element of independent claim 9, the rejection completely fails to address this claim element. DuLac et al. does not explicitly disclose a discovering means as recited in the second element of independent claim 9. However, it might be assumed that most network management programs incorporate some functionality that relies upon SNMP (Simple Network Management Protocol), and it is well-known that an SNMP-compliant device would include a discovery means.

With respect to the third element of independent claim 9, DuLac et al. does disclose a device that contains two network adapters. Thus, it is reasonable to assume that the two network adapters may be equivalent to the two network interface cards that are represented as two discovered endpoints as recited within the claim language of the third element of independent claim 9.

However, DuLac et al. does not disclose the fourth element of claim 9, i.e. "assigning means for assigning a mission criticality categorization to each discovered endpoint", notwithstanding the argument in the rejection to the contrary. The rejection states that this claimed feature is disclosed at column 6, lines 6-12, by stating "[DuLac, provide services to users, col 6 lines 6-12]." Applicant strongly disagrees that

DuLac et al. discloses the claimed feature. This cited portion of DuLac et al. states:

By proper video data layout and placement in storage module 102, no degradation will occur if high use videos are not all placed on one rank. The present invention also provides the advantage of providing service to more users by the increased bandwidth supplied by clear channel bus 104 and degraded mode bus 106 when protection from failed storage devices is not required.

Clearly, there is no support for the claimed feature in the passage as cited by the rejection. More importantly, DuLac et al. does not disclose the claimed feature in any manner; DuLac et al. does not contain any teachings that approach anything equivalent to categorizing one of two network adapters as being mission critical.

After examining independent claim 9, the Office action then turns its attention to dependent claims 10 and 11. The rejection of these two claims together states the following in its entirety: "It was clearly the parameters indicated a network status (i.e.: new device, error condition, connection failed, down, unknown, true) and subsequent action (i.e.: restart, updated, reroute)." This statement is unintelligible. Applicant asserts that DuLac et al. does not disclose any features with respect to these claims. For example, with respect to the first element of claim 10, DuLac et al. does not disclose anything similar to a means for designating each of a plurality of network interface cards with a monitoring parameter indicating that each of the plurality of network interface cards is a twin network interface card that is to be used for monitoring an associated network interface card, as required by the first element of claim 10, notwithstanding the rejection's argument to the contrary.

With respect to dependent claims 13, 14, and 16, the rejection merely copied the claim elements and then merely asserted that the claimed features were "inherent features of monitoring parameters". Applicant asserts that the lack of

argument in the rejection belies the argument that DuLac et al. discloses the claimed features. For example, DuLac does not disclose any features approaching the features of "fourth determining means for determining, in response to a determination that the target endpoint is a mission critical endpoint, whether the target endpoint is associated with a mission critical twin endpoint" and "rerouting means for rerouting, in response to a determination that the target endpoint is associated with a mission critical twin endpoint, the request for the action to the mission critical twin endpoint" as required by the claim language of claim 16. DuLac et al. clearly does not disclose anything concerning the designation of mission critical endpoints.

Independent claim 1 is directed to a method; claim 9 is directed to an apparatus; and claim 17 is directed to a computer program product. The Office action uses an anticipation argument against claims 1-8 and 17-24 by relying the arguments that are used against claims 9-16. Applicant's argument with respect to the rejection of claims 9-16 is similarly applicable against the rejection of claims 1-8 and 17-24.

DuLac et al. clearly does not disclose features as required by the language of the claims of the present application. As stated at MPEP § 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Hence, for this and other reasons, DuLac et al. cannot be used as an anticipatory reference, and the rejections of the claims have been overcome, whereby Applicant requests the withdrawal of the rejections.

VII. 35 U.S.C. § 102(e)–Anticipation–Eady et al.

The Office action has rejected claims 1-24 under 35 U.S.C. § 102(e) as anticipated by Eady et al., "Method and Apparatus for Controlling Medical Monitoring Devices Over the Internet", U.S. Patent No. 6,304,788 B1, filed 08/12/1999, issued 10/16/2001. This rejection is respectfully traversed.

The Office action begins by analyzing claim 9. Independent claim 9 reads as follows (as amended):

9. An apparatus for managing a distributed data processing system, the apparatus comprising:
configuring means for configuring monitoring parameters for network interface cards within the distributed data processing system using a network management framework;
discovering means for dynamically discovering endpoints within the distributed data processing system;
first determining means for determining that a device within the distributed data processing system has at least a first discovered endpoint representing a first network interface card and a second discovered endpoint representing a second network interface card; and
assigning means for assigning a mission criticality categorization to each discovered endpoint.

With respect to the first, second, and third elements of independent claim 9, the rejection states that the claimed features are disclosed by various elements in a server-client network, including a server that contains "one or more network interface cards". Assuming *arguendo* that most network management programs incorporate some functionality that relies upon SNMP (Simple Network Management Protocol) such that an SNMP-compliant device would include a discovery means and means for monitoring discovered endpoints, Eady et al. does not disclose the fourth element of claim 9, i.e. "assigning means for assigning a mission criticality categorization to each discovered endpoint", notwithstanding the argument in the rejection to the contrary. The rejection states that this claimed feature is disclosed by

stating "[Eady, retrieve instructions, col 5 lines 45-60]."

Applicant strongly disagrees that Eady et al. discloses the claimed feature. This cited portion of Eady et al. states:

5 Understand and provide control of medical-monitoring
devices no matter how sophisticated the device. For example,
if a user were to attempt to control the intervals at which
the device takes pulses, and that device did not have a
controllable period for taking pulses--medical-monitor
server 308 may identify this and return what parameters were
10 actually controllable on the device. Medical-monitor server
308 may also be configured to alter control requests to
allow the request to be serviced. For example, if the
medical-monitor device from the example above has a
controllable period for reporting to the server to retrieve
15 instructions, the command may be altered to change the
period of reporting, thereby allowing the server to be set
to request a pulse to be taken every time the device
reports.

20 Clearly, there is no support for the claimed feature in the
passage as cited by the rejection. More importantly, Eady et al.
does not disclose the claimed feature in any manner; Eady et al.
does not contain any teachings that approach anything equivalent
to categorizing one of two network adapters as being mission
25 critical.

Applicant asserts that it is entirely unclear why Eady et al. has been applied as a basis for rejecting any of the claims in the present patent application. Almost any prior art reference that discloses a client-server system would have been
30 as relevant as Eady et al.. Most of the dependent claims are rejected with completely insupportable and unsubstantiated arguments that the claimed features are "inherent features" in Eady et al..

Independent claim 1 is directed to a method; claim 9 is
35 directed to an apparatus; and claim 17 is directed to a computer program product. The Office action uses an anticipation argument against claims 1-8 and 17-24 by relying the arguments that are used against claims 9-16. Applicant's argument with respect to

the rejection of claims 9-16 is similarly applicable against the rejection of claims 1-8 and 17-24.

Eady et al. clearly does not disclose features as required by the language of the claims of the present application. As stated at MPEP § 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Hence, for this and other reasons, Eady et al. cannot be used as an anticipatory reference, and the rejections of the claims have been overcome, whereby Applicant requests the withdrawal of the rejections.

VIII. 35 U.S.C. § 102(e)-Anticipation-Allain et al.

The Office action has rejected claims 1-24 under 35 U.S.C. § 102(e) as anticipated by Allain et al., "Communication Controller U.S. Patent No. 6,449,259 B1, filed 06/30/1997, issued 09/10/2002. This rejection is respectfully traversed.

The Office action begins by analyzing claim 9. Independent claim 9 reads as follows (as amended):

9. An apparatus for managing a distributed data processing system, the apparatus comprising:
 configuring means for configuring monitoring parameters for network interface cards within the distributed data processing system using a network management framework;
 discovering means for dynamically discovering endpoints within the distributed data processing system;
 first determining means for determining that a device within the distributed data processing system has at least a first discovered endpoint representing a first network interface card and a second discovered endpoint representing a second network interface card; and
 assigning means for assigning a mission criticality categorization to each discovered endpoint.

With respect to the first element of independent claim 9, the rejection points to the features of Allain et al. concerning the monitoring of the quality of service (QoS) of a network, e.g., through a set of data I/O points within a communication controller, by stating "[Allain, monitoring the QoS of the networks, col 5 lines 15-65]".

With respect to the second element of independent claim 9, the rejection again points to the QoS monitor module. However, it might be assumed that most network management programs incorporate some functionality that relies upon SNMP (Simple Network Management Protocol), and it is well-known that an SNMP-compliant device would include a discovery means.

With respect to the third element of independent claim 9, Allain et al. does disclose a gateway that contains multiple gateway ports. Thus, it is reasonable to assume that the gateway ports may be equivalent to the two network interface cards that are represented as two discovered endpoints as recited within the claim language of the third element of independent claim 9.

However, Allain et al. does not disclose the fourth element of claim 9, i.e. "assigning means for assigning a mission criticality categorization to each discovered endpoint", notwithstanding the argument in the rejection to the contrary. The rejection states that this claimed feature is disclosed within multiple portions, by stating "[Allain, criteria signal data, col 6 line 64-col 7 line 14, 35-67; col 10 lines 35-52; col 12 lines 27-39]". Applicant strongly disagrees that Allain et al. discloses the claimed feature. The most relevant cited portion of Allain et al. states:

Communication controller 100 is also configured to receive information signals defined as criteria signals. Network Port 112 transfers the received criteria signals to User/System Criteria module 104 via connecting path 132. As with QoS monitor module 102, User/System Criteria module 104 can be assigned a unique address. This address can be stored in the protocol portion of the criteria signals allowing

Network Port 112 to detect such signals. The criteria signals contain network criteria data which can be established by the users and/or the service providers. That is, users can have the ability to set or establish the particular criteria under which they want to communicate with each other. Users having the capability to establish criteria can transmit criteria signals over the communication links to communication controller 100. The service provider may charge an extra fee to users with such capabilities; this is a billing policy issue that is to be decided by the service provider.

Clearly, there is no support for the claimed feature in the passage as cited by the rejection. More importantly, Allain et al. does not disclose the claimed feature in any manner; Allain et al. does not contain any teachings that approach anything equivalent to categorizing one of two network adapters as being mission critical, particularly the features concerning mission critical twin endpoints.

Although Allain et al. discloses criteria signals in the context of a network that supports quality of service features, Applicant asserts that it is quite a logical jump to state that the features of mission critical endpoints are somehow equivalent to any means that support these criteria signals in the system of Allain et al.. Most of the dependent claims are rejected with completely insupportable and unsubstantiated arguments that the claimed features are "inherent features" in Allain et al..

Independent claim 1 is directed to a method; claim 9 is directed to an apparatus; and claim 17 is directed to a computer program product. The Office action uses an anticipation argument against claims 1-8 and 17-24 by relying the arguments that are used against claims 9-16. Applicant's argument with respect to the rejection of claims 9-16 is similarly applicable against the rejection of claims 1-8 and 17-24.

Allain et al. clearly does not disclose features as required by the language of the claims of the present application. As stated at MPEP § 2131: "A claim is anticipated only if each and

every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Hence, for this and other reasons, Eady et al. cannot be used as an anticipatory reference, and the rejections of the claims have been overcome, whereby Applicant requests the withdrawal of the rejections.

IX. 35 U.S.C. § 103(a)—Obviousness—Walker in view of Brownmiller

The Office action has rejected claims 1-24 under 35 U.S.C. § 103(a) as unpatentable over Walker et al., "Network Management Event Correlation in Environments Containing Inoperative Network Elements", U.S. Patent Number 6,061,723, filed 10/08/1997, issued 05/09/2000, in view of Brownmiller et al., "System and Method for Monitoring Point Identification", U.S. Patent Number 5,768,255, filed 06/28/1996, issued 06/16/1998. This rejection is traversed.

As an initial point, Applicant notes that the rejections of the independent claims rely solely upon Walker et al. without modification. Thus, the rejection of the independent claims are not properly obviousness rejections because the rejections are formulated as anticipation rejections.

With respect to the first, second, and third elements of independent claim 9, the rejection states that the claimed features are disclosed by various elements in Walker et al.. Given that Walker et al. discloses functionality that relies upon SNMP (Simple Network Management Protocol) including discovery means and means for monitoring discovered endpoints, Applicant does not dispute these assertions of the rejection.

However, with respect to fourth element of independent claim 9, the rejection states that the feature of "assigning means for assigning a mission criticality categorization to each discovered endpoint" is disclosed in Walker et al. by stating: "[Walker, assigning UUID to the first and second interfaces, col 18 lines 65-67]". Applicant strongly disagrees that the use of a universally unique identifier (UUID) is equivalent to assigning a mission criticality categorization to an endpoint as required by the claim language. The mere fact that an endpoint can be uniquely identified within a system does not mean that each endpoint has a mission critical designation. Clearly, there is no support for the claimed feature in the passage as cited by the rejection. More importantly, Walker et al. does not disclose the claimed feature in any manner; Walker et al. does not contain any teachings that approach anything equivalent to categorizing one of two network adapters as being mission critical.

Although Brownmiller et al. discloses critical nodes, it does not disclose the designation of one of two NICs within a device as being mission critical or even merely critical. Moreover, Brownmiller et al. does not disclose a feature of a "service request indicates that no monitoring required" as asserted by the Office action on page 13. Most of the dependent claims are rejected with completely insupportable and unsubstantiated arguments that the claimed features are "inherent features" in Walker et al. and Brownmiller et al..

Independent claim 1 is directed to a method; claim 9 is directed to an apparatus; and claim 17 is directed to a computer program product. The Office action uses an anticipation argument against claims 1-8 and 17-24 by relying the arguments that are used against claims 9-16. Applicant's argument with respect to the rejection of claims 9-16 is similarly applicable against the rejection of claims 1-8 and 17-24.

Examiner bears the burden of establishing a prima facie case of obviousness

The examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). In response to an assertion of obviousness by the Patent Office, the applicant may attack the Patent Office's *prima facie* determination as improperly made out, present objective evidence tending to support a conclusion of nonobviousness, or both. *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

Walker et al. and Brownmiller et al. clearly fail to disclose at least one feature of the present invention as recited within each independent claim, notwithstanding the arguments presented by the Office action, thereby rendering Walker et al. and Brownmiller et al. incapable of being used as primary and secondary references as argued by the current rejection. Moreover, a hypothetical combination of Walker et al. and Brownmiller et al. would also fail to reach the claimed invention of the present patent application. As should be recognized, because both the primary and secondary references in the rejection fail to disclose the claimed features against which the references were applied, and because the references fail to be

combinable to produce these claimed features, the rejection fails to fulfill the requirements of a proper obviousness argument.

With respect to the claims of the present patent application, Applicant respectfully submits that it would not have been obvious for one having ordinary skill in the art to have used the applied prior art references to reach the claimed invention. Hence, a rejection of the claims cannot be based upon the cited prior art to establish a *prima facie* case of obviousness. Therefore, a rejection of the claims under 35 U.S.C. § 103(a) has been shown to be insupportable in view of the cited prior art, and the claims are patentable over the applied references. Applicant respectfully requests the withdrawal of the rejection of the claims.

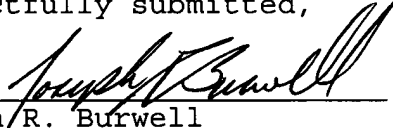
X. Conclusion

It is respectfully urged that the present patent application is patentable, and Applicant kindly requests a Notice of Allowance.

For any other outstanding matters or issues, the examiner is urged to call or fax the below-listed telephone numbers to expedite the prosecution and examination of this application.

DATE: November 10, 2004

Respectfully submitted,


Joseph R. Burwell
Reg. No. 44,468
ATTORNEY FOR APPLICANT

Law Office of Joseph R. Burwell
P.O. Box 28022
Austin, Texas 78755-8022
Voice: 866-728-3688 (866-PATENT8)
Fax: 866-728-3680 (866-PATENT0)
Email: joe@burwell.biz